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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,641	12/27/2001	Yasuhiro Doi	217717US0	7758

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EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/30/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/026,641

Applicant(s)

DOI ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Receipt is acknowledged of IDS, extension of time, and amendment B filed on 4/7/03 and 4/30/03. Claims 11-12 have been canceled and claims 13-23 have been added as per applicant's amendment dated 4/30/03. Claims 1-10 and 13-23 are pending in the application and the status of the application is as follows:

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- 1) Claims 1-2 are indefinite as the claims are drawn to compositions without any second component.

#### ***Response to Arguments***

3. Applicant's arguments filed 4/30/03 have been fully considered but they are not persuasive.
4. Applicants argue that that the composition claims without reciting second component are not indefinite in view of the open-ended expression " comprising" and therefore other cosmetically compatible ingredients could be incorporated in a composition
5. In response to the above argument, the examiners position is that the claims recite the expression" composition " without a second component. Therefore the claims as presented are drawn to product and not to compositions. The claims are ambiguous.

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6. Claims 18 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites "composition" without a second component. The claim lacks clarity.

Claim 21 lacks antecedent basis. The claim 1 does not recite "the surfactant other than the compound of formula (1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-10, and 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP abstract /JP patent 6178928 ('928) and Harry's cosmetology By Ralph Harry, pages 506-512 (1982).

**10. Applicants are notified that the examiner is relying on the JP document for the concentration of the cationic surfactant of formula (1).**

The instant application is claiming a hair cosmetic composition and method of conditioning the hair comprising:

- 1) Cationic surfactant of formula (1)
- 2) Surfactant which can be anionic, cationic, amphoteric or non ionic
- 3) Oil

The JP abstract teaches cationic surfactants structurally close to formula I claimed as conditioning agents for hair. See the formula in the abstract where n is 1. The only difference between this compound and the instant is the instant compounds are homologues. In the abstract the functional group attached to the oxygen atom when n is 1 is (CH<sub>2</sub>)<sub>2</sub> where as in the instant application the group attached to the oxygen atom is (CH<sub>2</sub>)<sub>3</sub>. The patent, at page 3 teaches surfactant in the formulations. The patent does not teach oil or cationic surfactant claimed in the instant application. However the Cosmeticology teaches conditioner formulations with surfactants and also oil. See page 207 for the cationic surfactants in the conditioner formulations and see page 509 where mineral oil or silicone oil is used in the conditioner formulations. The formulations teach various surfactants in the compositions.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of 'JP '928 and combine it with the *surfactants and oils* of 'cosmeticology, expecting conditioning effect to the hair since the instant cationic compounds of formula (1) are *homologues*. The motivation to combine the ingredients flows logically from the art for having been used in the same hair conditioning compositions. Absent a

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showing side by side comparison of the instant compounds vs. the compounds in the JP document commensurate with the scope of the claims, the claims are rendered *prima facie* obvious over the combination of the references.

***Response to Arguments***

11. Applicant's arguments filed 4/30/03 have been fully considered but they are not persuasive.

Applicants argue that in JP '928 reference ammonium compound is limited to the type in which the fatty hydrocarbon group is attached to at least one oxyethylene unit where as the ammonium salt of the present invention contains only one oxypropylene unit attached to the ammonium nitrogen atom and this difference is not trivial, especially in light of the fact that the reference only exemplifies a quaternary ammonium salt in which the ether bearing group attached to the nitrogen atom contains four successively linked oxyethylene group.

In response to the above argument, it is the position of the examiner that the abstract teaches that the "n" can be one and the patent teaches that n can 1-10. When n is 1 the instant claimed cationic compounds are higher homologues with additional methylene carbon atom. One of ordinary skill in the art would be motivated to add extra methylene group, with the reasonable amount of success expecting the compound to be also hair-conditioning agent.

Applicants argue that the Harry's Cosmetology discloses cationic surfactants which are quite different from the specific cationic surfactant of the present claims as well as the cationic surfactant disclosed in JP '928 reference and accordingly Harry's Cosmetology does not improve upon the deficiencies of '928 reference.

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12. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Harry's cosmeticology was relied for the teaching of the limitations, which are ingredients 2 and 3. These ingredients are conventionally used in hair conditioning products. Therefore one of ordinary skill in the art would be motivated to prepare compositions using the cationic surfactant of '928 and add extra methylene group since the compound would be higher homologue and add the conventional surfactants and oil taught by Harry's Cosmeticology to the compositions expecting hair conditioning properties.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
JYOTHSNA A VENKAT  
Primary Examiner  
Art Unit 1615

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July 29, 2003